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10/051,340

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EXAMINER

CHANKONG, DOHM

ART UNIT

PAPER NUMBER

2452

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/051,340

Applicant(s)

CHAUVIN ET AL.

Examiner

DOHM CHANKONG

Art Unit

2452

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23, 25-29, 34, 37-41 and 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23, 25-29, 34, 37-41, and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

This action is in response to Applicant's amendment and arguments filed on 6/16/2009. Claims 23, 25, 28, 29, 34, 37, 38, and 40 are amended. Claim 45 is added. Claims 1-22, 24, 30-33, 35, 36, and 42-44 were previously cancelled. Accordingly, claims 23, 25-29, 34, 37-41, and 45 are presented for further examination. This action is a final rejection.

Response to Arguments

With respect to claim 23, Applicant argues that the *Reifel* reference fails to disclose an order terminal "associated with one of a plurality of business entities." As Applicant notes, the previous rejection cited *Reifel*'s print houses as reading on the claimed business entities. *Reifel* also discloses an order terminal [Figure 1 | Figure 3 «item 308» | Figure 13 «items 20, 25»]. Thus, as Applicant also notes, to meet the claim, *Reifel* must teach that the order terminal is "associated" with the print houses.

Reifel does teach that a user may use an order terminal to access a web site associated with print houses in order to select and print specific images [column 5 «lines 16-19»]. When the terminal accesses the print house's web site [column 5 «lines 45-48»], the terminal becomes "associated" with the print house.

This interpretation is consistent with Applicant's specification which describes a user's home PC becoming "associated" with a business entity when it accesses the business entity's web site. Specifically, Applicant's specification states: "business entities (such as retail store owners and device or software suppliers) who control various types of order terminals, (such as photo kiosks, portable digital imaging devices, *or home PCs running application software*)" (emphasis

added) [USP 20030038882, para. 8]. In describing the application software running on the home PC, Applicant's specification further discloses that "a customer at block 48 may run a software application via a conventional web browser such as Netscape Navigator for gaining entry to system 10" [2003003882, para. 40]. Thus, according to Applicant's specification, a business entity may control a home PC (owned by a user) when the home PC runs a software application via a browser to access the photo services. Thus, consistent with Applicant's specification, *Reifel's* personal computer running a print house's web site meets the claimed limitation.

Also with respect to claim 23, Applicant argues that *Reifel* fails to disclose electronically reading a code stored on the portable digital storage device. However, *Reifel* discloses that camera-related information is stored in the camera's memory [column 13 «lines 10-14»]. Thus, when the camera-related information is provided to build the profile, it is electronically read from the camera's memory.

Finally with respect to claim 23, Applicant argues that *Reifel* fails to disclose displaying an order screen in response to reading the code stored on the portable digital storage device. *Reifel* discloses providing an order screen based on the camera-related information [column 12 «lines 28-48»]. Specifically, *Reifel* discloses providing specific print houses based on the camera provider (determined from the camera-related information or code) [column 5 «lines 29-44»]. Thus, the order terminal displays an order screen (with restricted print houses based on the camera provider which is determined from the camera-related information) in response to reading the code from the camera.

For the foregoing reasons, Applicant's arguments are not persuasive and the amended limitations fail to overcome the *Reifel* reference. The rejection set forth in the previous action is

therefore maintained. Applicant should note the new ground of rejection to address the amended limitations directed to the ranking of business entities and modification of purchasing information based on this ranking.

As to the double patenting rejection, the previous action indicated the wrong patent number in rejecting claims of the instant application on the ground of double patenting. The action identified patent number 7075244 but should have indicated patent number 7275044. Therefore, the terminal disclaimer filed by Applicant on 7/1/2009 is also incorrect. Applicant should file another terminal disclaimer indicating the correct patent number as indicated herein.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 23-29, 31, 32, and 34-43 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 7,275,044. Although the conflicting claims are not identical, they are not patentably distinct from each other because they only contain minor differences in the claim language. Taking claim 1 as the exemplary claim from the instant application and the '044 patent, both claims are directed to a method for providing photo services to a user. Both claims disclose maintaining business relationship data between service providers and business entities and providing specific services based on this maintained relationship data.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 23 lacks proper antecedent basis for "the relationship data" (last line of the claim).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- I. **CLAIMS 23, 25-27, 29, 34, 37, 39-41, AND 45 ARE REJECTED UNDER 35 U.S.C §103(A) AS BEING UNPATENTABLE OVER *REIFEL* ET AL, U.S PATENT NO. 7.013.288 [*“REIFEL”*] IN VIEW OF SIMONS, U.S. PATENT PUBLICATION NO. 2003|001331 [*“SIMONS”*].**

All citations in the following claim mappings are to *Reifel* unless otherwise noted.

Claims 23, 34, and 45

Reifel as modified by *Simons* discloses a method, system, and storage device comprising:
providing a network service on a network [Figure 1];

providing access for a user to a network server via the network service, the user accessing the network server, by using an order terminal connected to the network, for ordering products [Figure 1 | Figure 3 «item 308» | Figure 13 «items 20, 25»]; said order terminal associated with one of a plurality of business entities [see Response to arguments *supra* | column 15 «lines 36-44» | column 16 «lines 19-24»: business entity controls a home PC by running a software application via a browser to access photo services | Fig. 13 «items 20, 25»];

in response to a user coupling a portable digital storage device to a network connected order terminal [column 3 «lines 35-39»], electronically reading the portable digital device, the portable digital storage device associated with one of a plurality of service providers and having an image stored thereon [column 3 «line 53» to column 4 «line 4» | column 19 «lines 18-26 and 61-65: kiosk controlled by a service provider providing the storage device], said one of the plurality of service providers identified by electronically reading a code stored on the portable digital storage device [column 12 «lines 29-38» | column 13 «lines 10-14» : camera-related information stored on the camera], the plurality of service providers each having a predefined business relationship with said plurality of business entities [column 5 «lines 28-44» | column 12 «line 6»];

maintaining a relationship directory indicating a ranking of the predefined business relationships in a database coupled to the communication network [column 5 «lines 28-44» | column 12 «line 6» : camera provider can restrict the vendors from which the consumer can receive services or the consumer can pay a higher fee to use those vendors not associated with the manufacturer | *Simons*, 0087, 0088 & Table 1: categorizing ranked merchants based on their business relationships]; and

displaying to the user an order screen on said order terminal in response to reading the code stored on the portable digital storage device, the order screen including primary purchasing information provided by at least two of said plurality of business entities from which the user can order a product and/or service related to the image stored on the portable digital storage device, the primary purchasing information being modified in response to a ranking of a predefined business relationship between said one of the plurality of service providers and said at least two of the plurality of business entities [column 5 «lines 11-19 and 28-44» | column 12 «line 6» : *Reifel* discloses that a user may elect, by activating links to print houses or vendors that are approved by the camera provider or decide to use a lower rated vendor and pay a fee], wherein a modification of the primary purchasing information includes listing first on the order screen one of the at least two of the plurality of business entities that has a better ranking than another one of the at least two of the plurality of business entities, according to the relationship data in the database [*Simons*, 0086-0088: the entity operating the server modifying the listing of merchants based on their relationship to the entity].

While *Reifel* discloses at least two service providers (print houses), one of which has a higher ranking than the other [column 5 «lines 28-44» : a service provider that is preferred by the

manufacturer of the device has a "higher" ranking than a service provider that is not preferred], *Reifel* does not expressly disclose modifying an order screen such that the higher rated service provider is displayed first. However, this feature was well known in the art at the time of Applicant's invention as taught by *Simons*.

Simons is directed to a system for providing purchasing information (in the form of search results). As indicated in the foregoing mapping, *Simons* discloses an order screen whereby a user may select from a list of ranked business entities or merchants and discloses that the order in which the business entities are displayed is based on the specific business relationship. It would have been obvious for one of ordinary skill in the art to have applied *Simon's* ordering features to *Reifel's* teachings.

As noted above, *Reifel* discloses two service providers that have different relationships to a business entity. It would have been obvious for one of ordinary skill in the art, in reading *Simons*, to have organized the order screen such that the preferred service provider (the provider in which the manufacturer has a relationship) is listed prior to the business entity with whom the manufacturer does not have a relationship [column 5 «lines 41-45»]. One would have been motivated to provide such a modification to *Reifel's* photo service because displaying preferred providers first increases the possibility that the customer will see the better prices for printing the photographs and benefit the business entities with whom have a better business relationship.

Claims 25 and 37

Reifel as modified by *Simons* discloses modifying the primary purchasing information to include a lower purchase price from service providers if said ranking is better [column 5 «lines

28-44» | column 12 «line 6» : consumers receive cheaper prints at approved print houses or vendors].

Claims 26 and 39

Reifel as modified by *Simons* discloses said order terminal comprising one of the following, an automated teller machine, a kiosk, a personal computer, or a wireless device [Figure 13 «item 20»].

Claims 27 and 41

Reifel as modified by *Simons* discloses said portable digital storage device comprising one of the following: optical disc, magnetic floppy disk; flash memory device, or a digital camera [Figure 13 «items 5, 20»].

Claims 29 and 40

Reifel as modified by *Simons* discloses said one of a plurality of business entities provides one or more of the following: local printing of digital images, remote printing of digital images, on-line storage of digital images, providing digital storage media containing digital images, and providing associated goods and/or services with respect to hard copy prints [column 5 «lines 28-44»].

II. **CLAIMS 28 AND 38 ARE REJECTED AS BEING UNPATENTABLE OVER *REIFEL* AND *SIMONS*, IN VIEW OF VITTAL ET AL, U.S PATENT NO. 6.907.401 [“VITTAL”].**

Claims 28 and 38

Reifel as modified by *Simons* does not expressly disclose displaying different types of products and/or service on the order screen for the user to select, wherein some of the products and/or services are displayed more prominently based on said ranking of a predefined business

relationship between said one of the plurality of service providers and the merchant. However, Vittal discloses that such a feature was well known at the time of Applicant's invention.

Vittal specifically discloses modifying purchasing information based on relationships between the merchant and a service provider such that the merchant's product is displayed (advertised) more prominently [column 1 «lines 55-64» where : being advertised more prominently implies that that they are "displayed first"]. It would have been obvious to one of ordinary skill in the art to modify *Reifel* to include Vittal's teachings of prominently displaying provider products on a merchant's site based on a contract between the merchant and the service provider. One would have been motivated to modify *Reifel* as such functionality improves upon *Reifel*'s merchant-service provider system by increasing the number of options in the merchant-provider contract.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571.272.3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Primary Examiner, Art Unit 2452